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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,992	08/06/1999	ANNA KATE URSULA KARA	64-99	7524

23713 7590 03/03/2004

GREENLEE WINNER AND SULLIVAN P C  
5370 MANHATTAN CIRCLE  
SUITE 201  
BOULDER, CO 80303

EXAMINER

PORTNER, VIRGINIA ALLEN

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

**Advisory Action**

Application No.

09/369,992

Applicant(s)

KARA ET AL.

Examiner

Ginny Portner

Art Unit

3629/645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 05 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: the claims have not been entered as they raise new issues.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1,5-9,13-15,46.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 2. NOTE: the newly added phrase "15 or more consecutive nucleotides" is not required to be obtained from 1147-1740 of SEQ ID NO 1..

***Attachment to Advisory:***

The proposed amendment has not been entered as the combination of claim limitations raises new issues under 35 USC 112, first and second paragraphs for at least the following reasons:

- a. Claim 1 recites the phrase “wherein the probe or primer is nucleotides 1147 to 1740 of SEQ ID NO :1 or 15 or more consecutive nucleotides or a complementary nucleotide sequence thereto”.
  - i. What are the 15 or more consecutive nucleotides that are not obtained from the region of 1147-1740 of SEQ ID NO 1?
  - ii. Are the 15 or more consecutive nucleotides from SEQ ID NO 1 outside the recited range of nucleic acids 1147-1740?
  - iii. Are the 15 or more consecutive nucleotides derived from the sample or the extrachromosomal genetic element, as the claim still recites the phrase “or a nucleic acid derived therefrom”; the nucleic acid can be derived from the Plasmodium berghei extra chromosomal genetic element or the sample. The phrase “derived therefrom” refers back to both elements, as the term “therefrom” does not specify from which component the nucleic acid is derived, and more than one source of nucleic acid is recited in the “contacting” step.
  - iv. The written description (35 USC 112, first paragraph ) of a genus of any 15 or more consecutive nucleotides, from any sample source and evidencing any nucleotide sequence, and are not from the region 1147 to 1740 of SEQ ID NO 1 have not been described for utilization in the

instantly claimed method. The newly submitted combination of claim limitations define a subgenus of species not described in the instant specification, as the nucleic acid may be a derived nucleotide sequence from the sample or the genetic element; this genus of subspecies not evidencing original descriptive support.

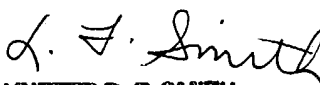
***Response to Remarks***

2. Applicant argues that the Amendment After Final sets forth the combination of claim limitations “nucleotides 1147-1740 of SEQ ID NO 1, or a portion consisting of 15 consecutive nucleotides set forth in SEQ ID NO 1”.

3. It is the position of the examiner that the claims have not been amended to recite the phrase used to traverse the rejections of record under 35 USC 112, first and second paragraphs. Applicant’s arguments are not commensurate in scope with the proposed claim amendments submitted After Final.

Upon further consideration of the claimed invention, it is the position of the examiner that 15 consecutive nucleotides should be taken from the range of nucleotides 1147-1740 of SEQ Id NO 1, and not just SEQ ID NO 1, to be directed to the examined, and finally rejected invention. Regardless of this reconsidered position, Applicant as not amended the claims to recite the combination of claim limitations used to traverse the rejection of record in order to gain entry of the Amendment After Final.

The proposed claim amendment does not recite "or a portion consisting of 15 consecutive nucleotide"; the claims recite open language "comprising". Applicant's arguments are not commensurate in scope with the proposed claim Amendment submitted After Final.

  
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